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OSMM&N File No. 198006US2 PCT

By: GJM:CDW:brf

Serial No. 09/623,519

In the matter of the Application of: Masakazu YAMAMOTO, et al.

For: DIAGNOSTIC SYSTEM FOR FLUID MACHINERY

The following has been received in the U.S. Patent Office on the date stamped hereon

- ☐ pp. Specification & Claims/Formal Drawings Sheets
- ☐ Combined Declaration, Petition & Power of Attorney pages
- ☐ List of Inventor Names and Addresses
- ☐ Utility Patent Application ☐ CPA
- ☐ Notice of Priority ☐ Priority Doc
- ☐ Check for ☒ Dep. Acct. Order For
- ☐ Fee Transmittal Form
- ☐ Assignment/PTO 1595 pages:
- ☐ Letter to Official Draftsman
- ☐ Letter Requesting Approval of Drawing Changes
- ☐ Drawings sheets ☐ Formal
- ☒ **Cover Letter**
- ☐ Amendment w/ Marked-up Copy
- ☐ Information Disclosure Statement ☐ PTO-1449
- ☐ Cited References
- ☐ Search Report
- ☐ Statement of Relevancy
- ☐ IDS/Related/List of Related Cases
- ☒ **Response to Restriction/Election Requirement**
- ☐ Rule 132 Declaration
- ☐ Request for Extension of Time
- ☐ Notice of Appeal
- ☐ Brief
- ☐ Issue Fee Transmittal
- ☐ White Advance Serial Number Card
- ☐
- ☐



☒ Due Date: 10-20-02

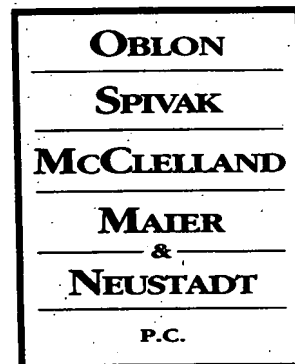
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DOCKET NO: 198006US2 PCT



ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231



Re: U.S. Application  
Serial No: 09/623,519  
Filed: November 6, 2000  
Examiner: LAU, T.  
Group: 2863  
Inventor: Masakazu YAMAMOTO, et al.  
For: DIAGNOSTIC SYSTEM FOR  
FLUID MACHINERY

ATTORNEYS AT LAW

GREGORY J. MAIER  
(703) 413-3000  
GMAIER@OBLON.COM

CHRISTOPHER D. WARD  
SENIOR ASSOCIATE  
(703) 413-3000  
CWARD@OBLON.COM

SIR:

Attached hereto for filing are the following papers:

**RESPONSE TO RESTRICTION/ELECTION REQUIREMENT**

Our check in the amount of **\$0.00** is attached covering any required fees. In the event that any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is attached.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

Gregory J. Maier  
Registration No. 25,599  
Attorney of Record

Christopher D. Ward  
Registration No. 41,367



**22850**

Tel. (703) 413-3000  
Fax. (703) 413-2220  
(OSMMN 11/98)

GJM:CDW:brf

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198006US2 PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :

Masakazu YAMAMOTO, et al.

: EXAMINER: LAU, T.

SERIAL NO: 09/623,519 :

FILED: November 6, 2000

: GROUP ART UNIT: 2863

FOR: DIAGNOSTIC SYSTEM FOR  
FLUID MACHINERY :

RESPONSE TO RESTRICTION/ELECTION REQUIREMENT

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

SIR:

In response to the restriction and election requirement dated September 20, 2002, the Applicants elect with traverse the invention of Group I corresponding to Claims 1-19, and 22-34, and further provisionally elect the species directed to flow rate and identify Claims 1-10 as readable on the provisionally elected species.

The Applicants respectfully traverse the election requirement for several reasons.

First, the outstanding Official Action merely includes the conclusory statement that this application contains claims directed to ... patentably distinct species ... "without stating any basis whatsoever in support of such a finding. This is in violation of MPEP § 816, which states:

The particular reasons relied on by the examiner for holding the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given. ...

In the absence of any annunciated basis, it is respectfully submitted that the PTO clearly has not carried forward its burden of proof to establish distinctness.

Secondly, MPEP § 806.04(f) requires:

Claims to be restricted to different species must be mutually exclusive. ..

The outstanding Official Action fails to address in any way whether the pending claims recite mutually exclusive characteristics and this failure provides a further basis for traversing the election requirement.

Finally, MPEP § 803 states:

... If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

The claims of the present invention would appear to be part of an overlapping search area.

Accordingly, the Applicants also respectfully traverse the outstanding restriction and election requirement on the grounds that a search and examination of the entire application would not place a *serious* burden on the Examiner.

Therefore, it is respectfully requested that the requirement to elect a single invention and species be withdrawn, and that a full examination on the merits of Claims 1-42 be conducted.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



**22850**

Tel. (703) 413-3000  
Fax. (703) 413-2220  
(OSMMN 11/98)

GJM/CDW/brf

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Gregory J. Maier  
Registration No. 25,599  
Attorney of Record

Christopher D. Ward  
Registration No. 41,367